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PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 1875.3920005

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature_____	Application Number 10/748,290	Filed December 31, 2003
	First Named Inventor Kevin Brown	
Typed or printed name _____	Art Unit 2416	Examiner Abdulla A. Riyami

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
   Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
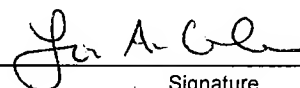(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____.

☒ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____50,633_____

_____
Signature

Lori A. Gordon
Typed or printed name

(202) 371-2600
Telephone number

April 22, 2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of ___1___ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Confirmation No.: 8408
BROWN *et al.*	Art Unit: 2616
Appl. No.: 10/748,290	Examiner: Riyami, Abdulla A.
Filed: December 31, 2003	Atty. Docket: 1875.3920005
For: **Apparatus and Method for Communicating Arbitrarily Encoded Data Over a 1-Gigabit Ethernet**	

Arguments to Accompany the Pre-Appeal Brief Request for Review

Mail Stop AF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit the following Arguments, in five (5) or less total pages, as attachment to the Pre-Appeal Brief Request for Review Form (PTO/SB/33). A Notice of Appeal is concurrently filed.

Arguments

Applicants' arguments in the Amendment and Reply under 37 C.F.R. § 1.111 filed on August 8, 2008 (hereinafter "Reply"), were not properly considered or responded to by the Examiner in the final Office Action mailed January 22, 2009 (hereinafter the "Office Action.") In the Office Action, independent claims 1, 8, and 16 were rejected under 35 U.S.C. § 103 as being allegedly unpatentable over Smith, *et al.*, U.S. Patent Number 6,813,651 ("Smith"), in view of Shippy *et al.*, U.S. Patent Application Publication Number 2005/0254645 ("Shippy"). The Examiner's response was legally and factually deficient because the Examiner failed to show that the cited references taught each and every feature of independent claims 1, 8, and 16 and failed

to show it would have been obvious to modify the cited combination to achieve

Applicants' claimed invention.

Smith describes an "interface device [that] allows communication between a

1394 device and an Ethernet via an 802.3 PHY." (Smith, Abstract). In Smith, "[d]ata

padding is used to make up for the difference in speeds between the 1394 link and

802.3 PHY." (Smith, col. 7, lines 40-43).

In Smith, for S800 mode, "four bytes of data are transmitted during a 5-byte

interval." Smith states that "the first two bytes received from the link are data," "[t]he

next two bytes received from the link are data," and "a third byte transmitted...is a

pad byte." (Smith, col. 7, lines 44-56). For S400 mode, during the 5-byte interval,

"two bytes of data are transmitted...during phase A" and "...three bytes of data are

transmitted during phase B. Each of the two original bytes are transmitted again

along with a pad byte to provide error correction." (Smith, col. 7, line 57 - col. 8, line

2). Finally, in S200 and S100 mode, the interface device extends the 4-bit and 2-bit

portion into eight bits by "duplicating the 4 bits" once for S200 mode and "duplicating

the two bits four times" for S100 mode. (Smith, col. 8, lines 4-16).

In the Office Action, the Examiner argues that Smith does teach "appending to

each byte (i.e., a byte is an ordered collection of bits, there is no standard defining the

amount of bits a byte must contain." (Office Action, p. 3.) Such a broad construction

of the term "byte" is impermissible. Under the broadest reasonable construction, the

Examiner must construe a term ***consistent with the specification*** (and consistent with

the understanding of that term to a person of skill in the art.) *See e.g., In re*

Yamamoto, 740 F.2d 1596 (Fed. Cir. 1984.) Both Applicants' specification and Smith

unquestionably use the term "byte" according to its well understood meaning and

standard usage in the art - i.e., 8 bits.

Through this construction, Examiner is arguing that, for example, in the S800 mode of Smith the "first two bytes received from the link" and "the next two bytes received from the link" combine to form a "byte." That is, four bytes equal a byte. Such an interpretation is inconsistent with the use of the term "byte" in Smith and is counter to its usage in the art.

As described above, Smith explicitly describes that padding is not appended to each "byte." Rather, Smith discloses modes in which a pad byte is transmitted after a set of data bytes. Thus, Smith does not teach or suggest a method including at least "appending to each byte in said first data stream a data type identification (DTID) .... thereby creating a technology independent data stream having a first bit rate" as recited in independent claim 1; a communications reconciliation sub-layer including "a transmit data type identification (DTID) circuit coupled to an output of a first transmission medium for appending a DTID to each byte in an original data stream, ... thereby generating a technology independent data stream at first bit rate that represents the original data stream from said first transmission medium," as recited in independent claim 8; or a communications sub-layer including "means for appending a data type identification to each byte in said first data stream, ... thereby creating a technology independent data stream from said first data stream, said technology independent data stream having a first bit rate," as recited in independent claim 16.

Furthermore, the "data padding" in Smith is not a data type identification. Rather, Smith states that "[d]ata padding is used to make up for the difference in speeds" and that "[t]o indicate the speed of the link data, a preamble byte is first transmitted."

As described in Smith, the preamble describes the speed of the 1394b packet (i.e., S100, S200, S400, or S800). Smith explicitly states that "[t]he preamble consists

of four identical preamble bytes." (Smith, col. 7 lines 26-27).   Thus, in Smith, the preamble is not appended to each byte of data.

Smith also does not teach or suggest using the preamble to identify the class of data being transmitted over 802.3. For example, the instant Specification recites "...a 2 bit data type identification (DTID) is appended to each byte of the 1394b S800 data stream 115 depending on the class of data field (e.g., data, request, or control)." (Specification, ¶[0050]). The instant Specification further recites "...DTIDS 701a-c are used to identify a class of data field or a data symbol." (Specification, ¶[0041]). Thus, Smith does not teach or suggest a method including at least "wherein the DTID identifies a class of data associated with the byte," as recited, using respective language, by independent claims 1, 8, and 16.

Shippy does not cure these deficiencies of Smith. Shippy describes a PCX data block 606 that is sent from a PCX module 106 to an application decoder 102. (Shippy, ¶[0055]). The PCX data block includes a header 608 portion and a payload 616 portion. (Id.) The payload portion includes a tag having "a stream identifier datum 612 for distinctly identifying the data stream, and a source datum 614 for distinctly identifying the stream source." (Id.) Therefore, the tag in Shippy uniquely identifies the stream, not the class of data in the stream, and the source of the stream. Accordingly, Shippy also does not teach or suggest "wherein the DTID identifies a class of data associated with the byte," as recited in independent claims 1, 8, and 16.

Furthermore, as described in Shippy, the "tag is inserted into the payload in the place of the saved payload portion." (Shippy, ¶[0066]). Shippy does not attach the tag to each byte in the stream. Instead, the tag in Shippy replaces the payload. (Shippy, ¶[0055]).
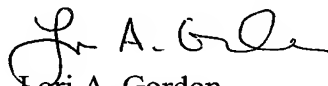
Thus, Shippy also does not teach or suggest a method including at least "appending to each byte in said first data stream a data type identification (DTID) …. thereby creating a technology independent data stream having a first bit rate" as recited in independent claim 1; a communications reconciliation sub-layer including "a transmit data type identification (DTID) circuit coupled to an output of a first transmission medium for appending a DTID to each byte in an original data stream, … thereby generating a technology independent data stream at first bit rate that represents the original data stream from said first transmission medium," as recited in independent claim 8; or a communications sub-layer including "means for appending a data type identification to each byte in said first data stream, … thereby creating a technology independent data stream from said first data stream, said technology independent data stream having a first bit rate," as recited in independent claim 16.

Thus, the combination of Smith and Shippy does not teach or suggest each and every feature of independent claims 1, 8, and 16.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

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Date: April 22, 2009

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